



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,550	02/23/2007	Hideji Tajima	10287.76	6278
27683 7590 12/29/2010 HAYNES AND BOONE, LLP IP Section 2323 Victory Avenue Suite 700 Dallas, TX 75219				
EXAMINER KILPATRICK, BRYAN T				
ART UNIT		PAPER NUMBER		
1772				
MAIL DATE		DELIVERY MODE		
12/20/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/561,550

Applicant(s)

TAJIMA ET AL.

Examiner

BRYAN T. KILPATRICK

Art Unit

1772

--THE MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 February 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(g).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: _____
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: "Decagonal prism" online article, 2010.

/SAM P SIEFKE/
Primary Examiner, Art Unit 1772

Continuation of 11, does NOT place the application in condition for allowance because:

Regarding Applicants' statements on p. 7-12 in the after final arguments/remarks filed on 14 December 2010 concerning instant claims 1-3, 7-12, and 29:

Applicants state on p. 8-9 that Tajima does not disclose a distributing section that distributes a substance on a wound film in distribution positions as required by instant claim 1. Examiner respectfully disagrees. Tajima discloses dispenser(s) having at least one material holding conduit and a suction/discharge device (Abstract and para [0091]). Tajima does disclose positioning dispensers (12 and 14, or 37 and 39 of Fig. 1) that have nozzles (13, or 36 and 38 of Fig. 1) for dispensing sample (para [0079]-[0080] and [0091]), and that the ends are organized in predetermined array, or matrix. Furthermore, it has been held by the courts that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function - In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); MPEP 2114 Apparatus and Article Claims - Functional Language, Apparatus Claims must be structurally distinguishable from prior art.

Applicants state on p. 9-11 that Tajima does not disclose a film that is wound around a cylindrical core so that portions of a film are arranged on a plane surface defined by one of a plate body and a prism, and that portions of a film are spaced in a parallel relation on a plane surface. However, Tajima employs a film that is transparent or semitransparent (para [0084]), like a prism, and a core that is connected and made from the same material as the film (para [0085]). Furthermore, Tajima discloses several forms of films that have flat surfaces (Fig. 3-4), like the plate discussed by Applicant in the after final remarks, that when wound around a core would have portions of a film on a plate surface and prism, and would place the wrapped film in a stacked orientation that would make portions of the film parallel to the core and plate surfaces within the film.

Applicants state on p. 11 that the Examiner has erred in his explanation regarding a prism and plane surface. As stated above, Tajima employs a film that is transparent or semitransparent, like a prism, (para [0084]), and a core that is connected and made from the same material as the film (para [0085]). Furthermore, Tajima discloses several forms of films that have flat surfaces (Fig. 3-4), like the plate discussed by Applicant in the after final remarks, that when wound around a core would have portions of a film on a plate surface and prism, and would have the wrapped film in a stacked orientation that would make portions of film parallel to the core and plate surfaces.

The Examiner discussed the shape of a decagonal prism (see online article) to show that even when an object has flat or plane surface portions, the object can still be disc-shape like the wrapped/wound film and core of Tajima (Fig. 7) that is made of a transparent or semitransparent material (para [0084]-[0085]), like a prism.

Regarding Applicants' statement on p. 12 in the after final remarks concerning instant claim 6:

Applicants state that none of the pluralities of nozzles shown in Fig. 1 of Tajima is arranged in a predetermined matrix, wherein the matrix corresponds to the "winding intervals of a foundation member" The language regarding the "winding intervals..." is not a limitation recited in instant claim 6, and has not been considered - may be new matter the requires further consideration and/or search.

Furthermore, Tajima does disclose positioning dispensers (12 and 14, or 37 and 39 of Fig. 1) that have nozzles (13, or 36 and 38 of Fig. 1) for dispensing sample (para [0079]-[0080] and [0091]), and that the ends are organized in predetermined organization, or matrix.

Regarding Applicants' statements on p. 12-16 in the after final remarks concerning instant claim 17:

Applicants state on p. 12-14 that Tajima does not disclose that a film is wound around a cylindrical core so that portions of the film are arranged on a plane surface and are spaced in a parallel relation on the plane surface at winding intervals. As previously stated above, Tajima employs a film that is transparent or semitransparent (para [0084]), like a prism, and a core that is connected and made from the same material as the film (para [0085]). Tajima discloses several forms of films that have flat surfaces (Fig. 3-4), like the plate discussed by Applicant in the after final remarks, that when wound around a core would have portions of a film on a plate surface and prism, and would place the wrapped film in a stacked orientation that would have portions of film parallel to the core and plate surfaces.

Applicants state on p. 14 that Tajima does not disclose a distributing section that distributes a substance on a wound film in distribution positions. As previously state above, Tajima discloses dispenser(s) having at least one material holding conduit and a suction/discharge device (Abstract and para [0091]). Tajima does disclose positioning dispensers (12 and 14, or 37 and 39 of Fig. 1) that have nozzles (13, or 36 and 38 of Fig. 1) for dispensing sample (para [0079]-[0080] and [0091]), and that the ends are organized in predetermined organization, or matrix. Furthermore, it has been held by the courts that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function - In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); MPEP 2114 Apparatus and Article Claims - Functional Language, Apparatus Claims must be structurally distinguishable from prior art.

Applicants state on p. 14-16 that Tajima does not disclose a foundation member rolling section. However, Tajima discloses the use of a spiral disk shaped carrier for substance detection manufactured using a thin slice of rolled film (Fig. 7 and para [0047]), similarly to the wound body made of a string or thread-like member of instant claim 1 with a flat face or surface. Tajima discloses winding a base member while maintaining an organized spacing so as to allow a sample that has been distributed can easily pass through the spacing (Fig. 10 and paragraphs [0116]-[0118]). In addition, Tajima discloses integration and cutting devices for rolling and slicing films prior to after rolling (para [0026]). Applicants state on p. 15 that Tajima does not disclose that a wound film "is not taken out for rolling it up around another core at narrower intervals than said winding intervals." The previously highlighted language does not appear to be a limitation recited in instant claim 17, and has not been considered - may be new matter the requires further consideration and/or search.

Regarding Applicants' statements on p. 16-18 in the after final remarks concerning instant claims 18-20:

Applicants state on p. 16-18 that Tajima does not disclose that a film is wound around a cylindrical core so that portions of the film are arranged on a plane surface and are spaced in a parallel relation on the plane surface at winding intervals. As previously stated above,

Tajima employs a film that is transparent or semitransparent, like a prism, (para [0084]), and a core that is connected and made from the same material as the film (para [0085]). Tajima discloses several forms of films that have flat surfaces (Fig. 3-4), like the plate discussed by Applicant in the after final remarks, that when wound around a core would have portions of a film on a plate surface and prism, and would have the wrapped film in a stacked orientation that would make portions of film parallel to the core and plate surfaces.

Applicants further state on p. 16-18 that Tajima does not disclose distributing substance on a wound film. Tajima discloses dispenser(s) having at least one material holding conduit and a suction/discharge device (Abstract and para [0091]). Tajima does disclose positioning dispensers (12 and 14, or 37 and 39 of Fig. 1) that have nozzles (13, or 36 and 38 of Fig. 1) for dispensing sample (para [0079]-[0080] and [0091]), and that the ends are organized in predetermined organization, or matrix. Tajima-2 discloses a liquid processing method for using a pipette device to pipette a substance from inside a vessel and transferring the substance to another liquid or target (Abstract of Tajima-2), which encompasses the holding and contact steps of instant claims 18-20. Since the Abstract of Tajima discloses an apparatus that employs a suction/discharge device that is similar to the pipette device disclosed in the Abstract of Tajima-2, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the apparatus of Tajima to perform the method of Tajima-2 for the purpose of transferring a liquid from one location to another for the purpose of executing an analysis process such as detection (Abstract of Tajima-2, and paragraph [0142] of Tajima). Furthermore, it has been held by the courts that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function - *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); *MPEP 2114 Apparatus and Article Claims - Functional Language*, Apparatus Claims must be structurally distinguishable from prior art.